

REMARKS

In reply to the Office Action mailed November 10, 2008, the Applicants request reconsideration.

35 U.S.C. §101

There is no rejection under 35 U.S.C. §101.

The Applicants note the Examiner's comments on page 8 of the Office Action, in which the Examiner refers to the recent decision *In re Bilski* (Fed Cir 2007-1130, October 30, 2008), *Diamond v. Diehr*, 450 US 175, 184 (1981), *Parker v. Flook*, 437 US 584, 588 n.9 (1978), *Gottschalk v. Benson*, 408 US 63, 70 (1972), *Cochrane v. Deener*, 94 US 780, 787-88 (1876), and "recent Federal Circuit decisions" which are not cited. The Examiner states that the "rejection above" (presumably the §103 rejection, discussed below) is "still maintained . . . due to the recent changes in 35 U.S.C. §101 (which raise) a §101 issue with claims 34-41."

Respectfully, the Applicants do not understand the maintenance of a rejection (made Final) for obviousness under §103 in light of an unsupported §101 "problem" based on a Federal Circuit decision issued months after the recent Reply dated July 1, 2008. Further, the Reply did not include any new amendments requiring new consideration of issues under 35 U.S.C. §101. Therefore, the Applicants respectfully request a new non-final Office Action having a reset period for response, in which the §103 rejection is withdrawn for the reasons stated below, and in which any §101 rejection deemed appropriate by the Examiner is set forth in proper detail.

Objections

Claims 34-41 and 46-48 stand objected to because of alleged informalities on page 2 of the Office Action. The Applicants address these matters as follows.

The Examiner suggests that the limitation generating an original analyzed structured document of a structured document to be searched would be better recited as --generating an original analyzed structured document to be searched--. The Applicants note that the former expression recites that the original analyzed structured document is generated of the structured document to be searched. In other words, the original analyzed structured document is different from the structured document. However, the Applicants adopt the Examiner's kind suggestion in order to advance prosecution.

Further, the Examiner objects, in claim 34, to "removing predefined elements from the original analyzed structured document . . . strings of higher-rank elements and of the removed predefined elements to thereby generate a structured document for full-text search . . . ". The Examiner suggests to amend the expression to recite "removing predefined elements from the original analyzed structured document . . . strings of higher-rank elements and the removed predefined elements to thereby generate a structured document for full-text search . . . ". Although it is believed that the former expression is grammatically proper, the Applicants have adopted the Examiner's kind suggestion to advance prosecution.

The Examiner suggests that claims 46-48 have similar problems. Therefore, these claims have also been amended in accordance with the Examiner's suggestions.

The Examiner also objects to claim 35 as reciting “a structured document searching and displaying method according to claim . . .”, and suggests that this be rewritten as “The computer-implemented method for searching and displaying the structured document according to claim . . .”. The Examiner also states that claims 36-41 should be amended in the same way. This suggestion has also been adopted.

35 U.S.C. §103(a)

Claims 34-41 and 46-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tateno, U.S. Patent No. 5,778,400 (Tateno) in view of Aoyama et al., U.S. Patent No. 5,156,726 (Aoyama). This rejection was addressed in the Reply filed July 1, 2008, by noting that Aoyama was not available in a combination rejection under 35 U.S.C. §103(a) because it can only be applied via 35 U.S.C. §102(e), and was commonly owned with the present invention at the time the present invention was made. See 35 U.S.C. §103(c). Accordingly, without admitting to the propriety of the rejection, the Applicants respectfully request withdrawal of the rejection.

Moreover, Tateno does not teach to convert information on the position of the character string of a removed predefined element or tag, meeting the search query on the structured document for full-text search, into information on the position of the character string meeting the search query in the original analyzed structured document.

Furthermore, contrary to the Office Action, the Applicants point out that Aoyama fails to teach that predefined elements are removed from the original

analyzed structured document, and that content character strings of higher-rank elements and of the removed predefined elements are concatenated to generate a structured document for full-text search. Rather, Aoyama discloses extraction of a difference character string between structured documents in which tags having the contents, the difference of which is ignored at the time of comparison, are predefined. Because the content of the tag is ignored, one cannot say that the content of the tag is concatenated with the content of an upper element. Further, Aoyama does not disclose or fairly suggest to restore the ignored element or deleted element.

At this time, the Applicants do note the publication of the Japanese priority application to which Aoyama claims foreign priority benefits under 35 U.S.C. §119. Aoyama's Japanese priority Application No. 07-161398 was published in Japan on December 13, 1996 as Publication No. 08-329079. Therefore, although the Applicants believe that the Examiner is required to withdraw the rejection as noted above, because the disclosure of the U.S. patent is not available as a reference in a combination rejection, the Examiner may wish to consider this Japanese publication. The Applicants, however, do not believe the Japanese publication to be material prior art, or that the Japanese publication combined with Tateno is sufficient to render the claims obvious under 35 U.S.C. §103.

In view of the foregoing amendments and remarks, the Applicants request reconsideration of the rejection and allowance of the claims.

To the extent necessary, the Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to

the deposit account of Mattingly, Stanger, Malur & Brundidge, P.C., Deposit Account No. 50-1417 (referencing attorney docket no. ASA-724-02).

Respectfully submitted,

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